

REMARKS

By this Amendment, claims 1-2, 4-7, 11, and 22 have been amended and new claim 24 has been added. Claims 1-24 are therefore pending.

In view of the above amendments and below remarks it is believed that the pending claims are in a condition for allowance. Reconsideration of the pending claims and an indication of allowance is therefore respectfully requested.

Rejection of the Claims Under 35, U.S.C. § 102

Claims 1-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,461,296 to Ashvin H. Desai ("Desai"). Applicants respectfully traverse this rejection. Desai fails to disclose each and every feature of independent claims 1, 11, or 22. Claims 1-23 therefore do not read upon Desai and Desai does not anticipate the claims under 35 U.S.C. § 102(b).

Independent claims 1, 11, and 22 each include a limitation requiring "inserting a spring loaded needle through a perineum" of a patient and "actuating a spring mechanism" (claim 1) or "a spring loaded needle for insertion through a perineum" of a patient (claims 11 and 22). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Desai does not teach, disclose, or suggest all of the claimed features of claims 1, 11, and 22.

In the Office Action, the Examiner takes the position that Desai discloses a system for delivering a denervating agent to a prostate gland that includes a spring mechanism. While the Office Action states that Desai does not, in actuality, disclose a spring mechanism, it discloses an "actuating mechanism to control the distal end of the needle, thus, providing equivalent function at the spring bias to cause actuation." Office Action, October 3, 2006, at 2. Desai, rather, discloses a "hollow core needle 30" that is "extended by a slidable portion 28 of instrument 22 and directed at an appropriate angle . . . so as to cause the needle to be inserted, interstitially, into a tumor 32." Col. 5, lines 23-26. The slidable portion 28 of Desai does not include a spring

mechanism that, as stated in the present application, "spring biases needle 38 out of hole 30 very quickly, in order to bias needle 38 against the prostate tissue and improve the ability to pierce the prostate gland." Application as published, par. 40. The slidable portion 28 of Desai is manually pushed by the user's hand.

Since Desai does not teach, disclose, or suggest all of the limitations of each claim, Desai does not anticipate claims 1, 11, and 22.

In addition, each of dependent claims 2-10, 12-21, and 23 depend, directly or indirectly, on one of independent claims 1, 11, and 22 and are allowable for at least this same reason.

Applicants therefore respectfully request the Examiner to withdraw the rejection of claims 1-23 based upon Desai.

Rejection of the Claims Under 35 U.S.C. § 103

Claims 4, 8, and 19 were been rejected under 35 U.S.C. § 103(a) as being obvious over Desai in view of U.S. Patent No. 6,577,410 to Julian L. Henley et al. ("Henley"). Each of claims 4, 8, and 19 depend, directly or indirectly, on one of independent claims 1, 11, 22, and 24 and are therefore allowable for at least those reasons given above. Withdrawal of this rejection is therefore respectfully requested.

New Claim 24

New claim 24 recites a method of delivering a denervating agent to a prostate gland and includes limitations requiring "inserting a spring loaded needle through a perineum" of a patient and "actuating a spring mechanism." Claim 24 is therefore allowable for at least the same reasons given for claim 1 above.

Conclusion

The Examiner is respectfully requested to contact the undersigned by telephone at 763.505.0409 or by e-mail at scott.a.marks@medtronic.com with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 13-2546.

Respectfully submitted,

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